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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92057921
Party	Defendant Howl USA LLC
Correspondence Address	HOWL USA LLC 30 WEST HUBBARD STREET, SUITE 2000 CHICAGO, IL 60654 UNITED STATES
Submission	Answer
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Date	11/04/2013
Attachments	Howl USA LLC Answer.pdf(487623 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of U.S. Registration No. 4394833

HOWL AT THE MOON RESTAURANT & BAR LLC)	
)	Cancellation No. 92057921
Petitioner,)	
)	
-against-)	
)	
HOWL USA, LLC. f/k/a Howl at the Moon Saloon,)	
LLC,)	
)	
Respondent.)	

ANSWER

Respondent, HOWL USA, LLC, ("Howl USA" or "Respondent") hereby answers the Petition for Cancellation (the "Petition"), filed September 24, 2013, of Petitioner Howl at the Moon Restaurant & Bar, LLC, Petitioner ("Petitioner") as follows:

1-INTRODUCTION

First Paragraph. Respondent is without sufficient knowledge or information to form a belief as to the allegations contained in this Paragraph and, therefore, denies the same.

Second Paragraph. Admits that Respondent has owned and operated bars under the service mark HOWL AT THE MOON since 1990 and that its principal place of business is 30 West Hubbard Street, Suite 2000, Chicago, Illinois 60654, and that it provides live entertainment with "dueling pianos", but denies the remaining allegations in this paragraph.

Third Paragraph. Admitted.

Fourth Paragraph. Admits that Petitioner responded to Respondent's cease and desist letter, but denies the remaining allegations of this paragraph.

Fifth Paragraph. Admits that Respondent filed a federal civil action in the U.S. District Court for the Southern District of New York claiming, *inter alia*, service mark infringement, but denies the remaining allegations of this paragraph.

Sixth Paragraph. Admits that Respondent owns a U.S. Trademark Registration under U.S. Registration No. 4,394,833 for the service mark HOWL AT THE MOON, but denies the remaining allegations of this paragraph.

2-The Law

Respondent admits that Petitioner sets forth the text of 15 U.S.C. § 1064, but denies the allegation set forth in the last sentence of this paragraph.

3-First Cause of Action

Denied.

4-Second Cause of Action

Denied.

PRAYER

Respondent denies that Petitioner is entitled to any relief, including the relief sought in the Prayer clause of its Petition for Cancellation.

AFFIRMATIVE DEFENSES

Respondent sets forth below its affirmative defenses. By making these affirmative defenses, Respondent does not assume the burden of proving any fact, issues, or element of a cause of action where such burden properly belongs to Petitioner. Moreover, nothing stated herein is intended or shall be construed as an acknowledgement that any particular issue or subject matter is relevant to Petitioner's allegations.

FIRST AFFIRMATIVE DEFENSE

Petitioner's Cancellation is barred because Petitioner fails to state a claim upon which relief may be granted.

SECOND AFFIRMATIVE DEFENSE

Petitioner's cancellation is barred under the doctrine of unclean hands. In particular, a civil action is currently pending in the United States District Court the for Southern District of New York, captioned "Howl USA. LLC v. Howl-at-the-Moon, Inc., Howl at the Moon Restaurant & Bar, L.L.C. and Howl at the Moon Restaurant Corp." Civil Action No. 1:13 cv 4035 (JSR), in which Respondent has alleged claims of service mark infringement against Petitioner for infringing Respondent's HOWL AT THE MOON service mark. Attached as Exhibit A is a true and correct copy of the complaint in that civil action.

PRAYER FOR RELIEF

WHEREFORE, Respondent contends that the Petition is entirely without ground and requests that the Petition be dismissed in its entirety with prejudice.

Dated: New York, New York
November 4, 2013

Respectfully submitted,

MANATT, PHELPS & PHILLIPS, LLP

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HOWL USA, LLC

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of Respondent **HOWL USA, LLC's ANSWER** is being served on counsel for Petitioner via first class mail this 4th day of November, 2013, at the following address:

Virginia Ivanova, Esq.
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Elmhurst, New York 11373
ivanovalaw@gmail.com

s/Darren W. Saunders

202279669.1

EXHIBIT A

DUKE RABOFF

13 CIV 4035

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HOWL USA, LLC

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK**

HOWL USA, LLC,

Plaintiff,

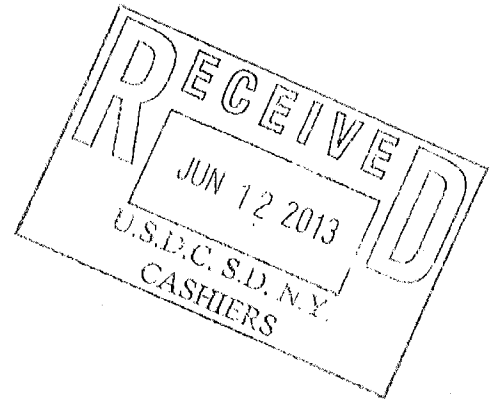
-against-

HOWL-AT-THE-MOON, INC.,
HOWL AT THE MOON RESTAURANT &
BAR, L.L.C., and HOWL AT THE MOON
RESTAURANT CORP.

Defendants.

Civil Action No.:

ECF CASE



COMPLAINT

Plaintiff Howl USA, LLC, by and through its attorneys, Manatt, Phelps & Phillips, LLP, for its complaint against Defendants HOWL-AT-THE-MOON, INC., Howl At the Moon Restaurant & Bar, L.L.C., and Howl At the Moon Restaurant Corp. (hereinafter collectively referred to as "Defendants"), alleges as follows:

NATURE OF THE ACTION

1. This is an action for: infringement of Plaintiff's registered service mark under 15 U.S.C. § 1114; false designation of origin in violation of 15 U.S.C. § 1125(a); dilution of Plaintiff's service mark in violation of 15 U.S.C. § 1125(c); injunctive relief and damages under 15 U.S.C. §§ 1114, 1118, 1119 and 1125; violation of Section 360-1 of the New York General Business Law; and violation of the common law of the State of New York.

JURISDICTION AND VENUE

2. This Court has jurisdiction over the subject matter of this action pursuant to 15 U.S.C. § 1121, 28 U.S.C. §§ 1331 and 1338, and has supplemental jurisdiction pursuant to 28 U.S.C. § 1367(a).
3. Venue is properly founded in this judicial district pursuant to 28 U.S.C. § 1391(b) and (c), because Defendants are subject to personal jurisdiction within this judicial district and/or because a substantial part of the events giving rise to these claims occurred in this judicial district.

PARTIES

4. Howl USA, LLC (hereinafter referred to as "Howl USA" or "Plaintiff") is a limited liability company organized under the laws of the State of Illinois, with its principal office at 30 West Hubbard Street, Chicago, Illinois 60654.
5. Upon information and belief, Defendant HOWL-AT-THE-MOON, INC. is a corporation organized under the laws of the State of New York, having its principal place of business at 585 East 189th Street, Bronx, New York 10458.

6. Upon information and belief, Defendant Howl At the Moon Restaurant & Bar, L.L.C. is a limited liability company organized under the laws of the State of New York, having its principal place of business at 585 East 189th Street, Bronx, New York 10458.
7. Upon information and belief, Defendant Howl At the Moon Restaurant Corp. is a corporation organized under the laws of the State of New York, having its principal place of business at 585 East 189th Street, Bronx, New York 10458.

PLAINTIFF'S HOWL AT THE MOON BARS

8. Howl USA owns and operates a group of bars with a unique entertainment concept – two live “dueling” piano players. Plaintiff opened its first HOWL AT THE MOON dueling piano bar in Covington, Kentucky, in 1990. Since then, Plaintiff has expanded into a chain of 13 company-owned and -managed HOWL AT THE MOON locations in: Baltimore; Boston; Charlotte; Chicago; Destin, Florida; Hollywood, California; Houston; Indianapolis; Kansas City; Louisville, Kentucky; New Orleans; Orlando; and San Antonio, Texas.
9. Plaintiff was the first bar in the United States to introduce the concept of having two dueling piano players with audience participation for the enjoyment and entertainment of its customers. The uniform theme of audience participation is a principal driver of the HOWL AT THE MOON dueling piano bars, which has made these bars so successful. Piano players take song requests and the audience sings along. The “World’s Most Dangerous Wait Staff” serves drinks and occasionally performs a dance number.
10. Howl USA makes substantial expenditures to advertise and promote its HOWL AT THE MOON bars, through various means, including on the Internet. Attached hereto as

Exhibit "A" is a screen shot of the homepage of Plaintiff's website:

www.howlatthemoon.com.

11. Plaintiff estimates that, to date, it has served in excess of 500,000 customers. As a result of the widespread popularity of Plaintiff's HOWL AT THE MOON bars, the brand name and service mark HOWL AT THE MOON has become extremely well-known, especially among young and middle-aged adults seeking a fun evening of live musical entertainment.
12. As a result of the extraordinary success of Plaintiff's dueling piano bars, Norwegian Cruise Lines opened HOWL AT THE MOON bars on two of its premier cruise ships. In July 2010, Plaintiff opened a HOWL AT THE MOON on the Norwegian Cruise Ship Epic. In May 2013 another HOWL AT THE MOON bar opened on the newest Norwegian Cruise Line ship, The Breakaway.
13. Plaintiff is presently seeking a location to open a HOWL AT THE MOON bar in New York City. To this end, Plaintiff is currently working with real estate brokers to find a suitable location.
14. Due to the importance of the HOWL AT THE MOON service mark and trade name, Plaintiff registered the name on May 5, 1992, in the United States Patent and Trademark Office (USPTO), under U.S. Trademark Registration No. 1,685,272 on the Principal Register, based on its use in commerce beginning in 1990. The registration is in full force and effect, and has become incontestable pursuant to 15 U.S.C. § 1065. A copy of the registration certificate is attached hereto as Exhibit "B."

DEFENDANTS' ACT OF INFRINGEMENT AND UNFAIR COMPETITION

15. Upon information and belief, Defendants are the owners and operators of a restaurant/bar under the name HOWL AT THE MOON restaurant/bars located in the Bronx, New York. Defendants advertise and promote their HOWL AT THE MOON on the Internet. A copy of a screen shot from Defendants' website is found at <http://howlatthemoonl.com> attached hereto as Exhibit "C."
16. Defendants' use of HOWL AT THE MOON was and continues to be without the authorization or consent of Plaintiff.
17. Upon information and belief, Defendants' adoption and use of HOWL AT THE MOON was subsequent to Plaintiff's registration of the mark in the USPTO.
18. Plaintiff's United States Trademark Registration provided constructive notice to Defendants of Plaintiff's prior and superior rights in and to the HOWL AT THE MOON service mark, throughout the United States.
19. Upon information and belief, Defendants have been and continue to be well aware of the extraordinary reputation that Howl USA has developed in its HOWL AT THE MOON dueling piano bars and the goodwill symbolized thereby.
20. Defendants' use of the name HOWL AT THE MOON in connection with the advertisement, promotion, and operation of a restaurant/bar in the Bronx is likely to cause confusion, mistake, or deception as to the source, sponsorship, or affiliation between Defendants and Plaintiff.
21. As a result of Defendants' use of Plaintiff's HOWL AT THE MOON name and registered service mark, consumers who expect to enjoy dueling piano player musical entertainment, for which Plaintiff has developed a national reputation, will be disappointed when entering Defendants' premises, where such entertainment is not

available. This will cause irreparable damage to Plaintiff's reputation and the goodwill which is symbolized by the HOWL AT THE MOON service mark.

22. By virtue of Defendants' unauthorized use of the HOWL AT THE MOON service mark, Plaintiff is unable to exercise quality control over the services offered by Defendants under Plaintiff's well-known name and service mark.
23. Plaintiff has encountered a number of instances of actual confusion, in which members of the public have been confused as to the source, sponsorship or affiliation of Defendants' services with that of Plaintiff.
24. Plaintiff has demanded on several occasions that Defendants cease and desist from using the well-known HOWL AT THE MOON mark for restaurant/bar services, but Defendants have refused. In view of Plaintiff's imminent geographic expansion into the New York metropolitan area, confusion among customers is highly likely, which will cause significant harm to Howl USA's established business reputation and valuable goodwill.

FIRST CLAIM FOR RELIEF

SERVICE MARK INFRINGEMENT UNDER LANHAM ACT 15 U.S.C. § 1114(1)(a)

25. The allegations set forth above in paragraphs 1 through 24 hereof are adopted and incorporated by reference as if fully set forth herein.
26. Plaintiff is the record owner of U.S. Trademark Registration No. 1,688,272 which identifies, *inter alia*, restaurant, bar and nightclub services, and which is valid, subsisting and incontestable.

27. Defendants, without authorization from Plaintiff, have used and are continuing to use the spurious designation HOWL AT THE MOON for their restaurant/bar services as their own brand name.
28. Defendants' use of HOWL AT THE MOON for such services is likely to cause confusion, or to cause mistake, or to deceive consumers into believing that Defendants' services are genuine, authorized or approved by Plaintiff.
29. Defendants' conduct constitutes trademark infringement in violation of 15 U.S.C. § 1114(1)(a).
30. Upon information and belief, Defendants' misappropriation and infringement of Plaintiff's mark was and is willful and intentional.
31. Upon information and belief, by their acts, Defendants have made and will continue to make substantial profits and gains to which they are not entitled in law or equity.
32. Upon information and belief, Defendants intend to continue their infringing acts, and will continue to infringe Plaintiff's registered HOWL AT THE MOON service mark, unless restrained by this Court.
33. Defendants' conduct has damaged and will continue to damage Plaintiff, and Plaintiff has no adequate remedy at law.

SECOND CLAIM FOR RELIEF

FALSE DESIGNATION OF ORIGIN 15 U.S.C. § 1125(a)

34. The allegations set forth above in paragraphs 1 through 33 hereof are adopted and incorporated by reference as if fully set forth herein.

35. Plaintiff is the record owner of U.S. Trademark Registration No. 1,688,272 which identifies, *inter alia*, restaurant, bar and nightclub services, and which is valid, subsisting and incontestable.
36. Defendants' advertisement, promotion, and use of Plaintiff's HOWL AT THE MOON service mark are intended and are likely to confuse, mislead, or deceive consumers, the public, and the trade as to the origin, source, sponsorship, or affiliation of Defendants' HOWL AT THE MOON restaurant/bar, and are likely to cause the public to believe in error that such services have been authorized, sponsored, approved, endorsed, or licensed by Plaintiff, or that Plaintiff is in some way affiliated with Defendants.
37. Defendants' acts constitute false designation of origin and false and misleading description and representation of fact, all in violation of 15 U.S.C. § 1125(a).
38. Upon information and belief, Defendants' misappropriation and infringement of Plaintiff's HOWL AT THE MOON service mark was and is willful and intentional.
39. Upon information and belief, by their acts, Defendants have made and will continue to make substantial profits and gains to which they are not entitled in law or equity.
40. Upon information and belief, Defendants intend to continue their infringing acts, and will continue to infringe Plaintiff's HOWL AT THE MOON service mark, unless restrained by this Court.
41. Defendants' acts have damaged and will continue to damage Plaintiff, and Plaintiff has no adequate remedy at law.

THIRD CLAIM FOR RELIEF

TRADEMARK DILUTION UNDER LANHAM ACT 15 U.S.C. § 1125(c)

42. The allegations set forth above in paragraphs 1 through 41 hereof are adopted and incorporated by reference as if fully set forth herein.
43. Plaintiff is the exclusive owner of the HOWL AT THE MOON service mark in the United States.
44. Plaintiff's service mark is distinctive and has been used for many years and has achieved enormous and widespread public recognition.
45. Plaintiff's HOWL AT THE MOON service mark is famous within the meaning of 15 U.S.C. § 1125(c).
46. Defendants' advertisement, promotion, distribution, sale, and operation of their restaurant/bar under the name HOWL OF THE MOON, without authorization from Plaintiff, are likely to dilute the distinctive quality of the HOWL AT THE MOON service mark and decrease the capacity of the service mark to identify and distinguish Plaintiff's bars.
47. Defendants have intentionally and willfully diluted and continue to dilute the distinctive quality of Plaintiff's HOWL AT THE MOON service mark in violation of 15 U.S.C. § 1125(c).
48. Upon information and belief, by their acts, Defendants have made and will continue to make substantial profits and gains to which they are not entitled in law or equity.
49. Upon information and belief, Defendants intend to and will continue to dilute Plaintiff's service mark, unless restrained by this Court.
50. Defendants' acts have damaged and will continue to damage Plaintiff, and Plaintiff has no adequate remedy at law.

FOURTH CLAIM FOR RELIEF

UNFAIR BUSINESS PRACTICE UNDER N.Y. GEN. BUS. LAW § 360-1

51. The allegations set forth above in paragraphs 1 through 50 hereof are adopted and incorporated by references as if fully set forth herein.
52. The service mark HOWL AT THE MOON is distinctive and has acquired secondary meaning in the marketplace; and is owned by Plaintiff.
53. Defendants' acts are likely to dilute, have diluted, and, unless enjoined by this Court, will continue to dilute the distinctive quality of Plaintiff's service mark.
54. As a direct and proximate result of Defendants' willful and wonton acts and conduct, Plaintiff's reputation and goodwill have been damaged.
55. Defendants' acts and conduct have caused irreparable injury to Plaintiff and to Plaintiff's reputation and goodwill, and will continue to do so unless enjoined by this Court.

FIFTH CLAIM FOR RELIEF

COMMON LAW SERVICE MARK INFRINGEMENT

56. The allegations set forth above in paragraphs 1 through 55 hereof are adopted and incorporated by reference as if fully set forth herein.
57. Defendants pursued the above stated actions with the intention of benefiting from, profiting upon, the goodwill associated with Plaintiff's HOWL AT THE MOON service mark. The goal is accomplished by Defendants' use of Plaintiff's service mark in the United States.

58. Defendants' use of Plaintiff's HOWL AT THE MOON service mark, unless restrained by this Court, will lead the public to believe that there is a connection or association between Defendants and Plaintiff, when in fact, there is none.
59. Upon information and belief, by their acts, Defendants have made and will continue to make substantial profits and gains to which they are not entitled in law or equity.

WHEREFORE, Plaintiff respectfully demands judgment against Defendants as follows:

- A. That the Court enter an injunction ordering that Defendants, their agents, servants, employees, and all other persons in privity or acting in concert with them be enjoined and restrained from:
- (a) using any reproduction, counterfeit, copy, or colorable imitation of the HOWL AT THE MOON service mark to identify any goods or the rendering of any services not authorized by Plaintiff;
 - (b) engaging in any course of conduct likely to cause confusion, deception or mistake, or to injure Plaintiff's business reputation or weaken the distinctive quality of the HOWL AT THE MOON service mark;
 - (c) using a false description or representation including words or other symbols falsely describing or representing Defendants' unauthorized restaurant/bar as being owned or operated by Plaintiff or sponsored by or associated with Plaintiff;
 - (d) further infringing the HOWL AT THE MOON service mark by marketing, advertising, promoting, displaying or otherwise operating a restaurant/bar under the HOWL AT THE MOON service mark;
 - (e) using any simulation, reproduction, counterfeit, copy or colorable imitation of the HOWL AT THE MOON service mark in connection with the promotion, advertisement, display, sale, operation of a restaurant bar in such fashion as to relate or connect, or tend to relate or connect in any way to Plaintiff, or to its HOWL AT THE MOON bars owned sponsored or approved by, or connected with Plaintiff;
 - (f) making any statement or representation whatsoever, or using any false designation of origin or false description, or performing any act, which can or is likely to lead the trade or public, or individual members thereof, to believe that the restaurant/bar operated by Defendants is in any way associated or connected with Plaintiff;

- (g) engaging in any conduct constituting an infringement of the HOWL AT THE MOON service mark, or Plaintiff's rights in, or to use or to exploit, said service mark, or constituting any weakening of Plaintiff's name, reputation or goodwill;
 - (h) using or continuing to use the HOWL AT THE MOON service mark or trade name or any variation thereof on the Internet (either in the text of a website, as a domain name, or as a key word, search word, metatag, or any part of the description of the site in any submission for registration of any Internet site with a search engine or index) in connection with any goods or services not directly authorized by, Plaintiff;
 - (i) effecting assignments or transfers, forming new entities or associations or utilizing any other device for the purpose of circumventing or otherwise avoiding the prohibitions set forth in subparagraphs (a) through (h).
- B. Directing that Defendants, within ten (10) days of Judgment, take all steps necessary to remove from all websites they own or control, all text or other media counterfeits of the HOWL AT THE MOON service mark.
- C. Directing that Defendants, within thirty (30) days of Judgment, file and serve Plaintiff with a sworn statement setting forth in detail the manner in which Defendants have complied with this injunction pursuant to 15 U.S.C. § 1116(a).
- D. Directing that Defendants deliver up for destruction to Plaintiff all unauthorized advertisements in their possession or under Defendants' control bearing the HOWL AT THE MOON service mark or any simulation, reproduction, counterfeit, copy or colorable imitation thereof, and all plates, molds, matrices and other means of production of same pursuant to 15 U.S.C. § 1118.
- E. Directing such other relief as the Court may deem appropriate to prevent the trade and public from deriving any erroneous impression that services provided or promoted by Defendants are authorized by Plaintiff or related in any way to Plaintiff's bars.
- F. Ordering that Plaintiff recover the costs of this action, together with reasonable attorneys and investigators' fees and prejudgment interest in accordance with 15 U.S.C. § 1117.
- G. Ordering that, pursuant to 11 U.S.C. § 523(a)(6), Defendants be prohibited from a discharge under 11 U.S.C. § 727 for malicious, willful and fraudulent injury to Plaintiff.
- H. Directing that this Court retain jurisdiction of this action for the purpose of enabling Plaintiff to apply to the Court at any time for such further orders and interpretation or execution of any order entered in this action, for the modification of any such order, for the enforcement or compliance therewith and for the punishment of any violations thereof.

- I. Awarding to Plaintiff such other and further relief as the Court may deem just and proper, together with the costs and disbursements which Plaintiff has incurred in connection with this action.

Respectfully submitted,

MANATT, PHELPS & PHILLIPS, LLP

Dated: New York, New York
June 12, 2013

By: *Darren W. Saunders*
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